

REMARKS

Claims 1-79 are pending.

Applicant has added new claims 56-79. The newly added claims are fully supported by the originally-filed specification and drawings. For example, regarding claims 56-58, 62-64, 68-70, and 74-76, note, e.g., page 3, lines 24-25 and Figs. 1, 2, 6, and 8; and, concerning claims 59-61, 65-67, 71-73, and 77-79, note, e.g., page 4, line 26- page 5, line 2, page 5, lines 14-18, and Figs. 1, 6, and 8.

Before explaining why all of the pending claims are allowable, Applicant respectfully requests the Examiner to **withdraw the finality of the Office Action** for the following reasons.

The outstanding final Office Action is the first Office Action that has issued after the filing of a Request for Continued Examination ("RCE") on February 13, 2004. M.P.E.P. § 706.07(h) clearly indicates that "[t]he action immediately subsequent to the filing of an RCE . . . may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met." (Emphasis supplied.) According to M.P.E.P. § 706.07(b), after filing an RCE and thereby creating a new application, the claims of the new application may only be finally rejected in a first Office Action where "all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application."

Applicant submits that the finality of the outstanding Office Action is improper because "all" of claims 1-55, which were finally rejected in the Office Action, are not

drawn to the “same invention claimed” before filing the RCE, as required by the first condition (1) of M.P.E.P. § 706.07(b). For example, claims 13-55 were not prosecuted before the filing of the RCE, and those claims have a scope differing from the scope of claims 1-12 pending before the RCE was filed. Thus, at least claims 13-55 are not directed to the “same invention” as that set forth in the claims prior to filing the RCE. Consequently, the final rejection of at least claims 13-55 in the Office Action is improper according M.P.E.P. § 706.07(b) and (h).

In addition to the fact that the finality of the Office Action is improper because the “same invention” is not being claimed, Applicant respectfully submits that the finality is also improper because the second condition of M.P.E.P. § 706.07(b) permitting a first Office Action to be final (i.e., “all of the claims . . . (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application”) has not been satisfied. For example, none of the newly-cited art mentioned in the claim rejections of the August 5, 2004 Office Action was “of record” in the application prior to the mailing date of the Office Action. Id. Therefore, the finality of the Office Action is also improper in light of the second condition of M.P.E.P. § 706.07(b).

According to M.P.E.P. § 706.07,

present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

To provide Applicant with a "full and fair" opportunity to respond to the final Office Action, Applicant respectfully requests the Examiner to consider the above remarks and to withdraw the finality of the Office Action. If the Examiner refuses to grant this request to withdraw the finality of the Office Action, Applicant respectfully requests the Examiner to explain the assertion at page 20 of the Office Action about how "Applicant's amendment necessitated the new ground(s) of rejection." Such an explanation would be especially appreciated so that Applicant will have more information to include in a possible petition to the Group Director requesting withdrawal of the finality of the Office Action.

In the Office Action, claims 1, 2, 7-10, 13-15, 17-25, 27, 29-31, 33, 35-38, 42, and 44-55 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,661,937 to Doppler et al.; claims 3-6, 16, and 43 were rejected under 35 U.S.C. § 103(a) based on Doppler et al. in view of U.S. Patent No. 5,619,832 to Myrvold; claims 11, 12, 26, 28, 32, and 39-41 were rejected under 35 U.S.C. § 103(a) based on Doppler et al. in view of U.S. Patent No. 4,287,693 to Collette; claim 34 was rejected under 35 U.S.C. § 103(a) based on Doppler et al. in view of Collette and further in view of Myrvold.

Applicant respectfully disagrees with the claim rejections and submit that they should be withdrawn because the Office Action does not set forth a *prima facie* showing of obviousness. To carry the initial burden of establishing a *prima facie* case of obviousness, three basic criteria must be satisfied. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

For the reasons explained below, the Office Action does not meet the burden of establishing a *prima facie* case of obviousness.

Doppler et al.

Doppler et al. is cited as the primary reference in each of the Section 103 rejections in the Office Action. Doppler et al. discloses mezzanine floor “panels” 12 and 14 formed of a composite of highly compressed wood fibers, phenolic resin, and a wax emulsion. Col. 5, lines 4-6. To form a mezzanine floor 10 at a job site, holding screws 24 or an adhesive are used to fasten the panels 12 and 14 to a pre-installed corrugated metal layer 16 that includes toughs or recesses 18 and flat upper portions 20. Col. 7, lines 30-31 and 60-63. As in a typical mezzanine floor, the corrugated metal layer consists of corrugated sheet metal that “is rigidly connected, or secured, to a building frame” (e.g., secured to vertical and/or horizontal structural support beams of a building frame). Col. 1, lines 16-19 and 22-24. As shown in Fig. 3, when holding screws 24 are used to secure the panels 12 to the pre-installed corrugated metal layer 16, the holding screws extend through the panels 12 and 14 and also through holes formed in the flat upper portions 20 of the metal layer 16.

Independent Claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 Are Allowable Over Doppler et al. and the Other Cited References Because There is No Disclosure or Suggestion of a Panel Including a Lower Member Attached to an Upper Member

Applicant submits that the Section 103 rejections applied to independent claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 should be withdrawn because Doppler et al. and the other references cited in the Section 103 rejections lack any disclosure or

suggestion of a panel including a lower member attached to an upper member, as recited in each of those claims.

The Office Action at pages 2, 4, 6, 10, 15, and 19 asserts that Doppler et al. discloses a “flooring panel (10) including . . . lower member (16) attached to [an] upper member (12, 14).” At pages 8 and 16-17, the Office Action again cites reference numeral 16 for the asserted disclosure of a lower member, but those portions of the Office Action do not provide a clear indication of what, if anything, the Examiner has alleged as corresponding to any flooring panel(s).¹

Contrary to the assertions in the Office Action, reference numeral 16 of Doppler et al. does not correspond to a lower member of a flooring panel. As explained above, reference numeral 16 relates to a corrugated sheet metal layer that is rigidly connected, or secured, to a building frame. The corrugated sheet metal layer 16 does not constitute any part of a panel.

Doppler et al. specifically teaches fastening “panels” 12 to the sheet metal layer 16 during installation of the panels 12 at a job site. See col. 7, line 30- col. 8, line 23. Those panels 12 are not disclosed as including the corrugated sheet metal layer 16. Since Doppler et al. only uses the term “panel” or “panels” when referring to subject matter that is installed by fastening it to the sheet metal layer 16, it is completely unreasonable to assert that the sheet metal layer 16 constitutes any part of a panel.

¹ If the Examiner insists on maintaining the Section 103 rejection applied to independent claims 14 and 42, Applicant respectfully requests that the Examiner provide Applicant with an explanation of how she is applying the Doppler et al. reference in the rejection of those claims. In particular, Applicant requests that the Examiner clearly identify any structure in Doppler et al. allegedly corresponding to the recited first and second panels and all of the structure features associated therewith.

The panels 12 and 14 are panels before they are fastened to the sheet metal layer 16 and after they are fastened to the sheet metal layer 16. The sheet metal layer 16 does not suddenly become part of the panels 12 and 14 after the panels 12 and 14 are fastened to it.

Claim terms cannot be construed in a manner inconsistent with the understanding of one of ordinary skill in the art. As evidenced by Doppler et al.'s use of the term "panel" to refer to subject matter other than the sheet metal layer 16, it is clear that the named inventors of Doppler et al. and others of ordinary skill in the art would not consider the sheet metal layer 16 as constituting any part of a panel. Accordingly, the Office Action's attempt to assert that the sheet metal layer 16 could be equated with a lower member of a panel is completely inconsistent with the understanding of one of ordinary skill in the art.

Even hypothetically if it would be possible to assert that the "panels" 12 and 14 and corrugated sheet metal layer 18 together could be considered to be a hypothetical panel, there is nothing disclosed in Doppler et al. that would constitute structure configured to connect such a hypothetical panel, to another panel. Each of independent claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 recites subject matter associated with connecting panels together. More specifically, claims 1 and 33 recite at least one part of an interlocking assembly for interlocking an edge of a panel with an adjacent edge of another panel; claims 11, 12, 26, 39 recite a tongue and a groove for connecting a panel to an adjacent panel; claims 14 and 42 recite an edge of a first panel and an edge of a second panel configured to be connected together; and claims 24 and 53 recite an edge of an panel that comprises a groove configured to connect the edge of the panel

to an edge of another panel. Doppler et al.'s tongue 28 and groove 30 are used to connect interconnect panels 12 and 14, not to connect the Examiner's alleged hypothetical panels. Thus, even if the metal layer 16 could hypothetically be considered to be a lower member of a hypothetical panel, there would be no teaching of structure configured to connect such a hypothetical panel to another panel.

For at least these reasons, there is no teaching or suggestion of the panel(s) recited in claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53.

Independent Claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 Are Allowable Over Doppler et al. and the Other Cited References Because There is No Suggestion or Motivation for Doppler et al. to Include a Lower Member That Protects an Upper Member from Water

In the Office Action, the Examiner has apparently acknowledged that Doppler et al. does not mention whether the corrugated sheet metal layer 16 would protect an upper layer from water. Office Action at pages 2, 4, 6, 8, 10, 12, 13, 15, 17, and 19. Despite that apparent acknowledgement, the Examiner asserts:

Even though metal is corrosive, metal is still very well known to protect other elements from water and is known to permit free drainage. For instance, in the case of creek and river runoffs, metal trenches are formed to aid in water flow, or in the case of gutters, metal gutters protect homes from external damage and enhance water flow from the rooftop. Hence it would have been obvious . . . that the metal lower rigid member of DOPPLER et al. is capable of protecting the upper member from water.

Office Action at pages 2-3, 4-5, 6, 8-9, 10-11, 12, 13-14, 15, 17, and 19.

Applicants respectfully disagree with these assertions and submit that the Section 103 rejections should be withdrawn because there is no teaching or suggestion of the subject matter recited in each of independent claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53. In particular, there is no suggestion or motivation for Doppler et al.'s

disclosed subject matter to include a lower member that protects an upper member from water, as recited in those claims.

The Office Action does not set forth any motivation or suggestion for having Doppler et al.'s corrugated sheet metal layer 16 protect an upper member from water. "Even where obviousness is based on a single prior art reference teaching all of the individual elements of the claims [which is clearly not the case in the present instance], there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Regardless of whether this showing is based on an implicit or express showing in the reference, the Examiner "must provide particular findings related thereto." Id. (citing In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999))(requiring a "clear and particular" suggestion to combine or modify prior art references). It is "never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based." See M.P.E.P. § 2144.03.E; See In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); In re Ahlert, 424 F.2d 1088, 1092, 165 U.S.P.Q. 418, 421 (C.C.P.A. 1970).

The Office Action does not set forth any reason as to why one of ordinary skill in the art would have hypothetically had Doppler et al.'s sheet metal layer 16 protect an upper member from water. The mere fact that metal can be used to form drainage devices, such as metal trenches for creek and river runoffs or rain gutters for homes, has nothing to do with the issue of how one of ordinary skill in the art might consider configuring Doppler et al.'s sheet metal layer 16. The sheet metal layer 16 is not

disclosed as being associated with any type of drainage device and there is nothing in Doppler et al. dealing with the issues of water drainage or water protection. Therefore, it is completely improper to assume that since metal sometimes can be used to drain water, the sheet metal layer 16 could be used for water protection.

The mere possibility that Doppler et al. might be “capable” of water protection, as apparently asserted in the Office Action, is insufficient to establish a *prima facie* case of obviousness. Simply because references can be modified or combined is not a sufficient basis to establish a *prima facie* obviousness. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Accordingly, the Office Action’s assertions of mere capabilities are insufficient to support the Section 103 claim rejections.

Moreover, Doppler et al. teaches away from a construction that would provide water protection because Doppler et al. discloses the use of several screws 24 (Figs. 2 and 3) passing through the sheet material layer 16 and thereby requiring holes in the sheet material layer 16 that might possibly permit at least some water to pass through the layer 16. In light of the holes in the sheet material layer 16 needed to accommodate the screws 24, there is clearly no reason why one of ordinary skill in the art would have considered configuring the layer 16 in the manner proposed in the Office Action. To do so, would quite possible lead to destroying Doppler et al.’s disclosed teaching of being able to use screws for panel fastening.

Since there is no suggestion or motivation to have Doppler et al.’s disclosed subject matter include a lower member that protects an upper member from water, as

recited in independent claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53, the Section 103 rejections should be reversed.

Independent Claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 Are Also Allowable Over Doppler et al. and the Other Cited References Because There is No Suggestion or Motivation for Doppler et al. to Include a Lower Member That Permits Free Drainage of Water

The Office Action generally alleges that “it would have been obvious . . . that the metal lower rigid member of DOPPLER et al. is . . . capable of permitting the free drainage of water.” Office Action at pages 2-3, 5, 6, 8-9, 11, 12, 14, 15, 17, and 19.

Applicant respectfully disagrees. The Office Action sets forth no suggestion or motivation for modifying Doppler et al. to include a lower member that permits free water drainage. Simply because the layer 16 is made of metal provides no suggestion or motivation for configuring the layer 16 to permit free water drainage.

Since there is no disclosure or suggestion of a lower member that permits free drainage of water, as recited in claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53, the Section 103 rejections should be withdrawn.

Independent Claims 1, 11, 12, 14, 24, and 26 Are Also Allowable Over Doppler et al. Because There is No Teaching of a Lower Member Comprising a Plurality of Projections in the Form of Knobs

Claims 1, 11, 12, 14, 24, and 26 should also be allowable over Doppler et al. because Doppler et al. lacks any teaching of a lower member comprising a plurality of projections in the form of knobs, as recited in those claims.

The Office Action appears to cite reference numeral 18 of Doppler et al. for the asserted disclosure of projections. Doppler et al. discloses that reference numeral 18 relates to troughs or recesses of the corrugated metal layer 16. Nothing in Doppler et al. or the other cited references provides any teaching or suggestion of having the

troughs or recesses 18 in the form of knobs. Accordingly, claims 1, 11, 12, 14, 24, and 26 should be allowable for this additional reason.

All of the Section 103 Rejections Should Be Withdrawn and All of the Claims Should Be Allowable

Myrvold and Collette do not provide any suggestion to modify Doppler et al. to overcome any of the above-noted deficiencies and they are not relied on as such in the Office Action. Even hypothetically if those reference could be combined with Doppler et al. in the hypothetical manner proposed in the Office Action, the claimed subject matter would not be suggested.

For at least the reasons set forth above, independent claims 1, 11, 12, 14, 24, 26, 33, 39, 42, and 53 should be allowable and the Section 103 rejections applied to those claims should be withdrawn. Since claims 2-10, 13, 15-23, 25, 27-32, 34-38, 40, 41, 43-52, 54, and 55 depend from one of claims 1, 11, 14, 24, 26, 33, 39, 42, and 53, those dependent claims should be allowable for at least the same reasons that the claims from which they depend are allowable.

Regarding new claims 56-79, those claims each depend from one of the independent claims and should therefore be allowable.

Applicant respectfully requests that the Examiner reconsider the application, withdraw the finality of the previous Office Action, remove all of the claim rejections, allow all of the claims, and issue a Notice of Allowability in a timely manner.

Applicant notes that the Office Action contains a number of assertions concerning the claims, the related art, and allegedly well known subject matter. Applicant declines to subscribe to any assertion in the Office Action regardless of whether it might be addressed specifically herein.


If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

Please grant any extension of time and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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